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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,584	07/15/2003	Shoji Morita	023484-0150	6886
22428	7590	02/23/2006	EXAMINER	
FOLEY AND LARDNER LLP			KIM, YOON YOUNG	
SUITE 500			ART UNIT	
3000 K STREET NW			PAPER NUMBER	
WASHINGTON, DC 20007			1723	

DATE MAILED: 02/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/618,584

Applicant(s)

MORITA, SHOJI

Examiner

Yoon-Young Kim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8-19 is/are allowed.
- 6) ☒ Claim(s) 1-7 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

This Office Action is in response to the Amendment filed on December 2, 2005.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-4 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ernst et al., U.S. Patent No. 5,698,098 in view of Fukumori et al., U.S. Patent No. 5,902,479.

Regarding Claim 1, Ernst discloses an oil filter comprising: a housing main body (#40); a cover (#12) detachably attached to the housing main body on a vertically lower side thereof and having a recessed portion that opens toward a housing main body side; an inner tubular member (#15) interposed between the inner tubular member and the cover so as to be movable into and out of the recessed portion; a biasing unit (#18) for urging the inner tubular member in a direction to protrude from the recessed portion of the cover; and a filter element (#17) disposed in an oil flowing space defined between the housing main body and the cover for filtrating oil introduced thereinto; wherein the cover is in a state of being attached to the housing main body, the inner tubular member is pushed down into the recessed portion of the cover against a bias of the biasing unit (Fig. 1). However, Ernst does not disclose an inlet and outlet or a seal member. Fukumori teaches an oil filter comprising a housing main body (#40) having an oil inlet (#42) and outlet (#43) and a seal member (#11) interposed between the cover and

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another member. It would have been obvious to one of ordinary skill in the art to modify Ernst with the element of Fukumori because they are both oil filters and in order be able to make a liquid-tight connection (Col. 2, Lines 43-45).

Regarding Claim 2, Ernst discloses that the total volume of the cover and the inner tubular member when the inner tubular member protrudes maximumly from the cover is set larger than the maximum volume of oil that can remain in a space between the housing main body and the cover upon the removal of the cover (Col. 3, Lines 36-45).

Regarding Claim 3, Ernst discloses that the filter element is detachably attached to the inner tubular member (Col. 2, Lines 63-64).

Regarding Claim 4, Ernst discloses that the cover is threadedly engaged (#13) with the housing main body.

Regarding Claim 20, Ernst discloses an oil filter comprising: a housing main body (#40); a cover (#12) detachably attached to the housing main body on a vertically lower side thereof and having a recessed portion that opens toward a housing main body side; an inner tubular member (#15) interposed between the inner tubular member and the cover so as to be movable into and out of the recessed portion; a biasing unit (#18) for urging the inner tubular member in a direction to protrude from the recessed portion of the cover; and a filter element (#17) disposed in an oil flowing space defined between the housing main body and the cover for filtrating oil introduced thereinto; wherein the cover is in a state of being attached to the housing main body, the inner tubular member is pushed down into the recessed portion of the cover against a bias of the biasing unit (Fig. 1); and wherein the cover has an oil collecting portion at the bottom side outer circumferential periphery thereof (between #12 and #15). However, Ernst does not disclose an inlet and outlet or a seal member. Fukumori teaches an oil filter comprising a housing main body (#40) having an oil inlet (#42) and outlet (#43) and a seal

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member (#11) interposed between the cover and another member. It would have been obvious to one of ordinary skill in the art to modify Ernst with the element of Fukumori because they are both oil filters and in order be able to make a liquid-tight connection (Col. 2, Lines 43-45).

3. Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ernst in view of Fukumori as applied to Claim 1 above, and further in view of Faria, U.S. Patent No. 5,066,391.

Regarding Claim 5, Ernst discloses that the inner tubular member (#15) but does not disclose a partition wall or communication hole. Faria teaches an oil filter (#10) where the inner tubular member comprises a tubular wall (#78) and a partition wall (#74, 112) closing an end of the tubular wall, at least one of the tubular wall and the partition wall of the inner tubular member being provided with a communication hole (#110) for providing communication between the upper and lower oil collecting chambers. It would have been obvious to one of ordinary skill in the art to modify Ernst with the element of Faria in order to provide a passageway when the oil pressure exceeds a predetermined value (Col. 5, Lines 31-36).

Regarding Claim 6, Ernst discloses that the total volume of the cover and the inner tubular member when the inner tubular member protrudes maximumly from the cover is set larger than the maximum volume of oil that can remain in a space between the housing main body and the cover upon the removal of the cover (Col. 3, Lines 36-45).

Regarding Claim 7, Faria discloses that the communication hole is formed in the inner tubular member at the position thereof corresponding to the lowermost position (Fig. 2).

Allowable Subject Matter

4. Claims 8-19 are allowed.

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The following is an examiner's statement of reason for allowance:

The prior art of record neither teaches nor suggests a biasing unit that holds the partition member pressed against the housing main body so that the volume of the oil suction chamber increases as the cover is moved increasingly away from the housing main body upon removal of the cover. Baumann et al., U.S. Patent No. 6,65,829 B1 discloses an oil filter comprising a partition member disposed in the recessed portion of the cover so as to be movable into and out of the recessed portion and partitioning a space between the cover and the housing main body but does not disclose a biasing unit that presses the partition member against the housing. Although Ernst et al., U.S. Patent No. 5,698,098 does teach a biasing unit, it would not have been obvious to one of ordinary skill in the art to modify Baumann with the element of Ernst.

Response to Arguments

5. Applicant's arguments with respect to Claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

Ernst in view of Fukumori and Faria teach the invention as claimed.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yoon-Young Kim whose telephone number is (571) 272-2240. The examiner can normally be reached on 8:30-4:30, Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker can be reached on (571) 272-1151. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YK

02/17/06


JOHN KIM
Primary PATENT EXAMINER